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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,125	01/29/2004	Jean-Laurent Luquet	945-011672-US (PAR)	4365
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PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824			EXAMINER SEVERSON, JEREMY R	
			ART UNIT 3653	PAPER NUMBER
			MAIL DATE 01/07/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/767,125	<b>Applicant(s)</b> LUQUET ET AL.	
	<b>Examiner</b> Jeremy R. Severson	<b>Art Unit</b> 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "the mail device". There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tschiderer (US 5,363,998) in view of Ladds (US 4,155,643) and Haydock (US 2,963,761).

Tschiderer comprises a mail item receiving device for receiving the mail items ejected through an exit slot of a folding and inserting machine, the mail item receiving

device comprising a support plate (bottom part of device in fig. 3a) on which the ejected mail items ejected from a folding and inserting machine will accumulate, a front wall 20, joined to the support plate, on which these mail items will abut upon their ejection, two lateral walls (see fig. 1) joined to the support plate, and a rear wall (right side of device in fig. 3a), joined to the support plate and two lateral walls, configured to align these mail items once they have fallen on the support plate, and said rear wall comprises hooking means (see fig. 1) wherein said lateral walls each present an outer corner without sharp angle (see fig. 1); wherein each opening allows items received on the support plate to be accessed through the opening; wherein each of the lateral walls further comprises a rounded corner located opposite the support plate and rear wall.

Tshiderer additionally discloses an apparatus 42, 40 (shown in fig. 2) to be used with the tray. It would have been obvious to one of ordinary skill in the art at the time of the invention to not include this apparatus, in order to reduce the cost of manufacture of the tray.

Tschiderer lacks the explicit disclosure of said support plate comprising two hollows made on either side of its longitudinal axis at the level of its join with said front wall, wherein each hollow creates an opening between a respective lateral wall and the front wall. Ladds teaches such hollows in order to allow the copies to be grasped for removal. See Ladds, col. 2 lines 25 et seq. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add two hollows made on either side of its longitudinal axis at the level of its join with said front wall, wherein each hollow creates an opening between a respective lateral wall and the front

wall, to the apparatus of Tschiderer, as taught by Ladds, in order to allow the copies to be grasped for removal.

The hooking means of Tschiderer are not configured to cooperate with feet of a folding and inserting machine for connecting the receiving device to the folding and inserting machine. However, it is recognized in the connecting art that clips are equivalent to the hooking means disclosed by Tschiderer. Haydock discloses a clip attached to a tray with the purpose of securing a rod shaped object (see Fig. 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Ladds to include clip as taught by Haydock for the purpose of attaching the tray to cylindrical legs since Haydock's clips would provide a more secure attachment.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tschiderer in view of Ladds and Yamada (US 6,714,326).

In regard to claim 4, Tschiderer does not disclose reinforcing ribs. However, it is well known in the art that trays can include reinforcing ribs to strengthen the trays. Yamada discloses such a tray with ribs 2d, in order to help the smooth passage of documents. See Yamada, col. 6, lines 33 et seq. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Ladds include a tray with reinforcing ribs, as taught by Yamada, in order to help the smooth passage of documents.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tschiderer in view of Ladds and Firl (US 5,454,553).

In regard to claim 5, Tschiderer does not specifically disclose the material from which the tray is made. However, it is well known in the art that input and output trays are made from molded plastic. Firl discloses such a tray (col. 2, lines 65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Ladds include a tray made of molded plastic, as taught by Firl, since the trays could be produced via a inexpensive manufacturing process and further be a lightweight material.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tschiderer in view of Ladds and Yamada (Jap. Pat. No. 8-337349).

In regard to claim 6, Tschiderer does not disclose a transparent material from which the tray is manufactured. However, it is well known in the art that trays can be manufactured from transparent material. Yamada discloses such a tray (see abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Ladds include a tray manufactured from transparent material, as taught by Yamada, since it would improve visibility of the mail.

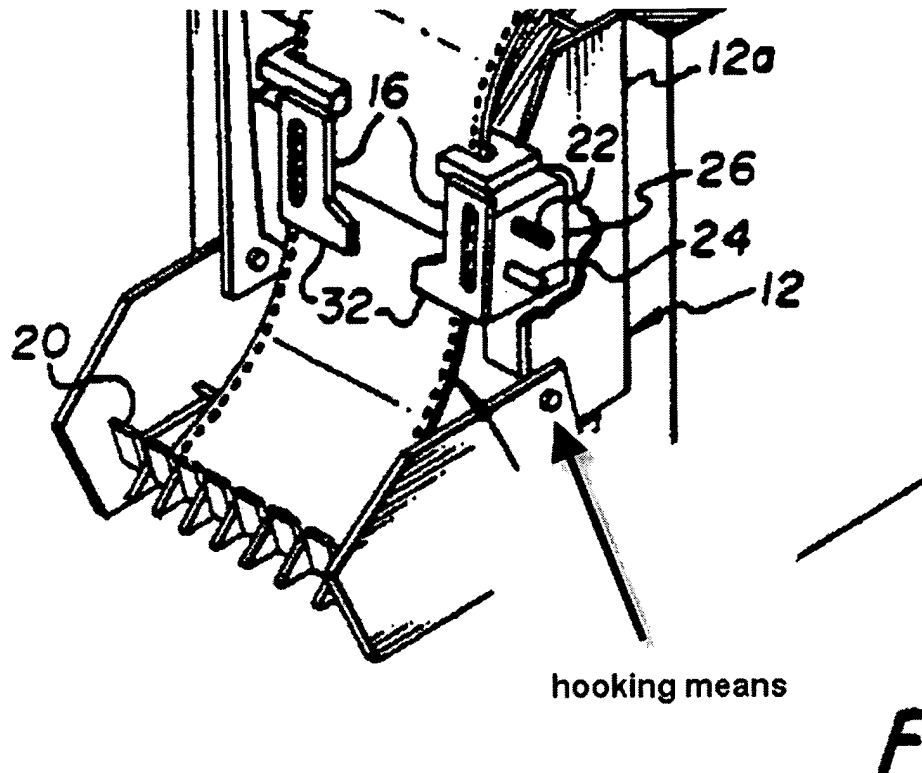
### ***Response to Arguments***

Applicant's arguments filed 25 October 2007 have been fully considered but they are not persuasive.

Applicant first argues that "Tschiderer only discloses an output tray (20) for receiving fan fold paper (10) from a reproduction apparatus (10). Nowhere in Tschiderer is it disclosed that the reproduction device is a 'folding and inserting machine' as recited in Applicant's claim 1. Nor is it disclosed in Tschiderer that the fan fold paper is 'ejected mail items' as recited in Applicant's claim 1."Remarks, p. 4.

The pertinent claim language is "where the mail item receiving device is configured to receive the ejected mail items from a folding and inserting machine". Claim 1, lines 10-11. This claim limitation is the intended use of the device. Recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, even though the prior art may not explicitly disclose use with a folding and inserting machine, if it is "configured" to receive the items therefrom, it anticipates the claim language.

Applicant further argues that Tschiderer does not disclose hooking means. Remarks, p. 5. The examiner respectfully disagrees. The hooking means are shown in fig. 1. As explained in the rejections above, replacing the hooking means of Tschiderer with the hooking means of Haydock would have been obvious to one of ordinary skill in the art.



Applicant further argues that it would not have been obvious to one of ordinary skill in the art "to not include" the apparatus (42, 40) (shown in Fig. 2) that is used with the tray in Tschiderer, because the fan fold paper tray would not operate as disclosed in Tschiderer if the floor member (42) and wall member (40) were removed, and that this rejection is based solely on hindsight. Remarks, p. 6. The examiner respectfully disagrees. It would have been obvious to one of ordinary skill in the art at the time the invention was made to remove the apparatus 42, 40 to reduce the cost of manufacture of the tray. Applicant is correct that the tray would not operate as disclosed in Tschiderer in the case of removing the apparatus 42, 40; however, if fan fold paper



were not being dispensed, a person of ordinary skill in the art would have known that such an apparatus would not be necessary.

Applicant further argues that the tray of Tschiderer is not capable of aligning mail items once they have fallen on the support plate, as "[i]f separate items were directed downward into the tray they would randomly fall into the tray and depending on where they land and how they fall (e.g. bend and twist while falling due to gravity, wind resistance, etc.) some of the items will lean against the walls while others lay flat on the bottom of the tray. There is absolutely nothing in Tschiderer that would cause separate items to be aligned as recited in Applicant's claim 1." Remarks, p. 7. The examiner respectfully disagrees. The rear wall in Tschiderer is a flat planar surface that is "configured to align these mail items once they have fallen on the support plate" (claim 1, lines 8-9), even if there are circumstances where items may not be aligned by the wall.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Severson whose telephone number is (571) 272-2209. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey, can be reached on 571-272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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